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BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			CASTELLANO, STEPHEN J	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte*

STEPHEN ALAN SMITH, KEVIN RAY SMITH, WARREN GILES  
WIEDMEYER, KIMBERLY VAILE HEALY, RANDY GOLDEN, RUDY  
DESCHAMPS, IRSHAD KHAN, BRYCE C. RUTTER, BRIAN C. BONE,  
JOHN H. LOUDENSLAGER, and JAN ROLF STILLERMAN

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Appeal 2008-3471  
Application 10/676,807  
Technology Center 3700

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Decided: November 17, 2008

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Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and  
MELANIE L. McCOLLUM, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 4-14.  
Jurisdiction for this appeal is under 35 U.S.C. § 6(b). We affirm.

#### STATEMENT OF THE CASE

The claims in this appeal are directed to nestable cups. Claims 1 and 4-14 are pending. The claims stand rejected as follows:

- 1) Claims 1 and 4-14 on the ground of nonstatutory obvious-type double patenting as obvious over the claims of U.S. Design Patent Nos. D514,385 S (Feb. 7, 2006), D514,380 S (Feb. 7, 2006), D505,830 S (Jun. 7, 2005), D504,593 S (May 3, 2005), D499,935 S (Dec. 21, 2004), D499,934 S (Dec. 21, 2004), and D514,884 S (Feb. 14, 2006) (all to Smith) in view of Hawley (U.S. Pat. No. 3,519,165, issued July 7, 1970) (Ans. 3);
- 2) Claims 1 and 4-14 on the provisional ground of nonstatutory obvious-type double patenting as obvious over claims 1, 2, 5-12, 14, 15, and 21-34 over copending U.S. Application No. 11/101,932 in view of Hawley (Ans. 3); and
- 3) Claims 1 and 4-14 under 35 U.S.C. § 103(a) as obvious over Edwards (U.S. Design Patent D196271, Sept. 10, 1963) in view of Hawley (Ans. 3).

The provisional obvious-type double-patenting and the Section 103 rejections, rejections 2) and 3) respectively, were not addressed in the Appeal Brief. As these rejections have not been withdrawn by the Examiner (Ans. 3), we summarily affirm.

Claim 1 is representative of the subject matter at issue in this appeal. Claim 1 reads as follows:

1. A container comprising:
  - an open top defined by an annular rim;
  - a base defining a lowermost surface of the container; and
  - a sidewall extending between the top and the base, the sidewall having an inner surface and an outer surface, the sidewall comprising a recess and an annular shoulder located

between the recess and the base, the annular shoulder comprising an arched portion, the annular shoulder forming an inner stacking surface on the inner surface of the sidewall and the arched portion forming a raised ledge on the inner stacking surface, wherein the base of a second identical container rests upon the inner stacking surface and the raised ledge sits within the arched portion of the second identical container when the second identical container is nested upon the container.

#### ISSUE

Claims 1 and 4-14 stand rejected for non-statutory obvious-type double-patenting over the claims of seven design patents (Ans. 3).

The Examiner states that it would have been obvious to have made the claimed invention by removing the structure from the cited design drawing claims, “as such structure is not necessary” (Ans. 6). Appellants argue that obvious-type double-patenting has not been established because the Examiner made only a one-way determination of obviousness (the “one-way test”), not a two-way determination (the “two-way test”) as necessary when rejecting claims for obvious-type double-patenting over design patent claims (App. Br. 5-6).

Thus, the issue in this appeal is as follows: Is the one-way or two-way test the appropriate standard for the obviousness determination at issue in this rejection?

#### ANALYSIS

Claim 1 in this appeal is directed to a container having an open top, a base, and a sidewall “comprising a recess and an annular shoulder located between the recess and the base.” The annular shoulder comprises “an arched portion” which together form an “inner stacking surface” upon which a “second identical container is nested.”

Seven different design patents are cited by the Examiner as claiming the same structure as in claim 1, including the annular shoulder and arched portion (Ans. 5), but with additional design features (Ans. 5). A comparison between the drawings of the instant application (*e.g.*, Figs. 4-5) and those in the design patents (*e.g.*, Smith D514,884, Fig. 5) indicate that the inner stacking surface formed by the recess, annular shoulder, and arch are the same and correspond to the structure which is claimed in the instant application. Appellants do not appear to have disputed this fact.

The Examiner applied the one-way test for obviousness-type double patenting over the design patent claims, finding that it would have been obvious to “nest” a second container upon the first container and to have eliminated the additional design features of the seven cited Smith patents to have made the claimed invention (Ans. 5-6).

Citing *Carman Indus. Inc. v. Wahl*, 724 F.2d 932 (Fed. Cir. 1983) and *In re Dembiczaik*, 175 F.3d 994 (Fed. Cir. 1999), Appellants take the position that a two-way determination is necessary when an obvious-type double-patenting rejection of a utility application claim is made over a design patent claim (App. Br. 5).

*Carman* involved patented claims to an apparatus attached to a storage bin or hopper. *Carman*, 724 F.2d at 934. The claims were alleged to be invalid for double-patenting in view of an earlier issued design patent to the same inventor. *Id.* at 936. The court stated that “double patenting between a design and a utility patent presents significant problems” because they “are based on different statutory provisions” and the “scope of protection afforded by each type of patent is different.” *Id.* at 938-939. That is, a “utility patent” protects the way an article is used and works (35 U.S.C.

101), while a “design patent” protects the way an article looks (35 U.S.C. 171). *See* MPEP 1502.01 (Eighth Edition, Aug. 2001; rev. July 2008). However, despite the differences because the two types of patents, the court acknowledged that double patenting can exist when “the two patents ‘cross-read,’ i.e., claim the same thing.” *Carman*, 724 F.2d at 939. The court stated that “[d]ouble patenting may be found in a design/utility setting ‘irrespective of whether the patent relied on in the rejection and the application [or patent] on appeal involve the same invention, or whether they involve inventions which are obvious variations of one another.’” *Id.* at 940 (citations omitted). In such a case, the court held that a “two-way test” is appropriate, i.e., “whether one patent claims an obvious variation of that which the other patent claims, and vice versa.” *Id.* at 941.

*In re Dembiczak, supra*, was a case in which the invention was “a large trash bag made of orange plastic and decorated with lines and facial features, allowing the bag, when filled with trash or leaves, to resemble a Halloween-style pumpkin, or jack-o’-lantern.” *Dembiczak*, 175 F.3d at 998. The utility patent application claims at issue in the appeal were rejected as obvious variants over a claim in an earlier issued design patent. *Id.* As in *Carman*, the court held that the two-way test is required when utility claims are rejected as obviousness-type double-patenting over the claims of a design patent. *Id.* at 1002. Thus, a determination must be made as to whether the utility application claims are obvious in view of the design patent claim and vice-versa, i.e., whether the design patent claim would be

obvious over the utility patent claims.<sup>1</sup>

The utility patent claims in this appeal, as in *Dembiczak*, are rejected under obviousness-type double-patenting over design patent claims. The Examiner states that the “fact situation” differs from *Carman* and *Dembiczak*, but does not explain how (Ans. 6). To the contrary, we agree with Appellants that principles enunciated in *Carman* and *Dembiczak* are applicable to the situation here and that a two-way test is the proper standard for making a determination of obviousness-type double-patenting. As the Examiner only addressed the first “way” of the test, a *prima facie* case of obviousness-type double patenting has not been set forth. We therefore reverse the rejection of claims 1 and 4-14.

#### CONCLUSION OF LAW

Because we decide that the Examiner applied the one-way test for obviousness, rather than the two-way determination, we reverse the non-statutory obviousness-type double patenting rejection of claims 1 and 4-14.

The rejection of claims 1 and 4-14 under provisional obvious-type double-patenting and § 103 is summarily affirmed.

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<sup>1</sup> “In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are ‘basically the same as the claimed design.’ *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996); *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).” *Dembiczak*, 175 F.3d at 1002.

Appeal 2008-3471  
Application 10/676,807

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc

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